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			ART UNIT 2128	PAPER NUMBER
			NOTIFICATION DATE 01/26/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com
teresa.carvalho@wilmerhale.com
sharon.matthews@wilmerhale.com

Office Action Summary	Application No. 09/502,133	Applicant(s) HELSON, HAROLD E.	
	Examiner Hugh Jones	Art Unit 2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9 and 13-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9 and 13-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/4/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 9, 13-35 of U. S. Patent 09/502,133 are in front of the office for consideration and remain pending. Claims 2-8, 10-12 are canceled.

Information Disclosure Statement

2. Applicants have submitted a fourth voluminous IDS. Many of the extremely long manuals also appear to be cumulative. In view of the extremely complex and dense material, and the extremely large number of pages, Applicants assistance is requested if Applicants wish a limited number of relevant pages be reviewed in depth. This issue has been previously raised with Applicants.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1, 13-34 are rejected under 35 U.S.C. 101 as being directed to nonstatutory subject matter since the claims are not proper process claims.**

4. The claims are not process claims as defined by the courts because they are not tied to another statutory class (such as a computer) and there is no claimed transformation of matter. Furthermore, note the machine must be a particular machine and be more than incidental to carrying out the claimed method. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499

Art Unit: 2128

F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one. For the same reason, claims reciting incidental physical transformations also may not pass muster under section 101. To permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law. In *Benson*, the Court drew the conclusion that "transformation" is the clue to patent-eligibility "of a process claim that does not include particular machines." *Benson*, 409 U.S. at 68-71.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 9, 13-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helson (The inventor's PhD thesis - of record) in view of Benecke et al. (Applicant's IDS) and the taking of official notice.

8. Helson discloses:

identifying, from a connection table for a chemical structure, an instance of chemical structural symmetry in the chemical structure (pp. 145-149; fig. 4.5; chapter 4; fig. 3.5, pg. 221, fig. 4.9, fig. 5.4);

wherein the instance of symmetry includes symmetrically equivalent atoms and bonds (page 246; fig. 4.5; chapter 4, fig. 4.9, 5.4);

positioning atoms and bonds in the chemical structure diagram pp. 145-149; page 246; fig. 4.5; chapter 3).

Note page 203-211 (redrawing)

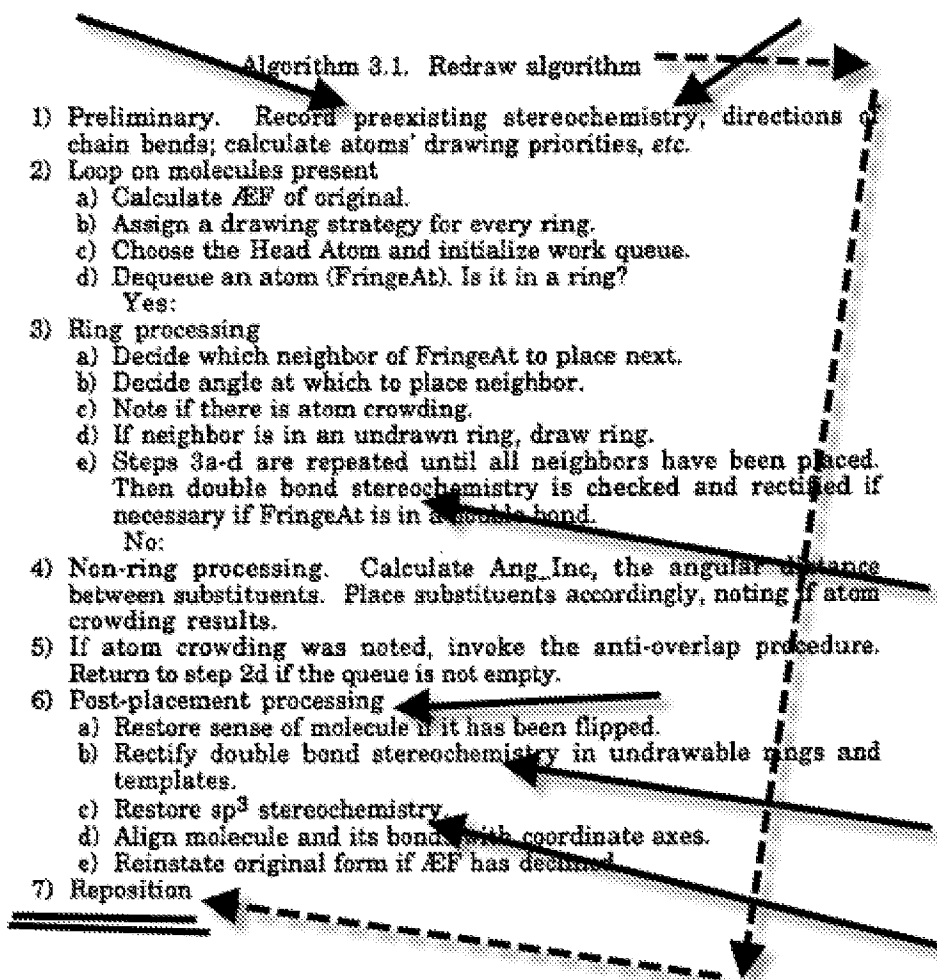
204

Table 3.1. Criteria for Aef_Redraw

Criterion	Weight*	Description
1	12	Bond overlap
2	3	Bond alignment
3	2	Angle alignment
4	8	Bond distribution
5	4	Alignment and zigzag of chains
6	2	Alignment of ring bonds
7	4	Macroorientation of ring systems
8	6	Symmetry
9	8	Uniform bond length
10	12	Atom crowding

*When a criterion is not applicable to a molecule its weight is set to zero. Similarly, the weights for criteria 5, 6 and 7 are adjusted to reflect the importance of the criterion to the molecule at hand.

And (pg. 149):



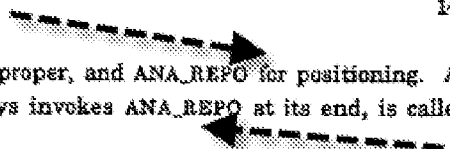
9. Note that the redraw algorithm calls the reposition algorithm. See page 145-146:

Implementation in CAMEO

In CAMEO, SDG is divided into two independent processes: SDG proper, referred to as "redrawing," and positioning of the resulting molecules, called "repositioning." Both facilities exist as independent packages of routines that may be called to serve different occasions; they are not rigidly tied to any particular phase of the program. In fact, repositioning does not even require perception, although redrawing does. The two executive

Art Unit: 2128

146



routines are REDRAW for SDG proper, and ANA_REPO for positioning. At present REDRAW, which always invokes ANA_REPO at its end, is called from the following places:

Also see the table of contents:

	v
	Page
CHAPTER 3. STRUCTURE DIAGRAMS FROM CONNECTION TABLES	126
Abstract	126
Introduction	126
Purpose and Context of SDG	127
Challenges to an SDG Algorithm	130
Complex Ring Systems	130
Special Morphologies	133
Atom and Bond Overlap	136
Precedents	138
STR3 (1973)	138
Carhart (1976)	140
CAS (1977)	142
Spektren (1982)	143
Shelley (1983)	143
University of Hull (1990)	144
DEPICT (1990)	144
Implementation in CAMEO	145
Redraw Algorithm	148
Outline	148
Simple Ring Drawing and the Irregular Polygon Method	156
Complex Monocyclic Rings	160
Bicyclic Ring Systems	163
Avoiding Congestion: Atom Priority, the Fleeing Heuristic, and the Congestion Function	164
Removal of Atom and Bond Overlap and Crowding (the RBS Heuristic)	167
Reposition Algorithm	173
Analytic Repositioning Algorithm	175
Dynamic Repositioning Algorithm	185
The Jumping Heuristic	194
Æsthetic Functions and the Testing Database	200
AeF_Repo: æsthetic Function for Positioning Molecules	202
AeF_Redraw: Æsthetic Function for Redrawing	203
The Testing Database	211

	vi
	Page
A Unified Repositioning Algorithm.....	228
Acknowledgement.....	230
References and Notes.....	231
CHAPTER 4. DETECTION OF SYMMETRY AND DUPLICATE PRODUCTS.....	233
The need for Symmetry Perception and Identical Structure Identification.....	233
Symmetry.....	234
Identical Products.....	234
Which Symmetry is Required?.....	237
Approaches to Isomorphism and Automorphism.....	239
Approaches to Isomorphism.....	241
Path-Growing Yields Symmetry as well as Isomorphism.....	242
Morgan Algorithm.....	243
Approaches to Symmetry.....	245
Placement in CAMEO.....	246
Goals of Symmetry Perception in CAMEO.....	249
Implementation of Symmetry Perception in CAMEO.....	252

10. Helson does not appear to disclose

laying out atoms/bonds to express the identified symmetry

as previously argued by Applicants.

11. Benecke et al. discloses laying out atoms/bonds to express the identified symmetry (pg. 45):

Each of the structural isomers may exist in several configurations in space. MOLGEN⁺ is capable of generating all possible configurational isomers, again redundancy free (which, of course, also implies the consideration of symmetries).

The notion stereoisomerism is not uniquely defined in chemistry; it should therefore be stated which kinds of effects are taken into account. Primarily there are: (i) chirality of tetravalent atoms, even in rings and spiranes, and (ii) enantiomerism and diastereomerism of allenes including *cis/trans*-isomerism.

The construction of the stereoisomers is performed in two steps: First the molecular graph is examined for stereochemical properties and the complete set of configurational isomers is generated without any use of three-dimensional information. This method is based on [6], improved by [9]. Table 2 shows the numbers of stereoisomers corresponding to all structural isomers of a single gross formula.

In the second step spatial realizations of these isomers are calculated by the application of appropriate geometrical transformations to the placement computed above. (The basics of these calculations, which are again discussed in [7], can be found in [8].) In Fig. 2 the four stereoisomers of 1,2,3,4-tetramethylcyclobutane are displayed as an example.

12. It would have been obvious to one of ordinary skill in the art at the time of the invention to so modify Helson in order to generate all configurations to facilitate chemical research.

13. As for dependent claims, Benecke et al. discloses (pg. 45):

Each of the structural isomers may exist in several configurations in space. MOLOEN⁺ is capable of generating all possible configurational isomers, again redundancy free (which, of course, also implies the consideration of symmetries).

The notion stereoisomerism is not uniquely defined in chemistry; it should therefore be stated which kinds of effects are taken into account. Primarily there are: (i) chirality of tetravalent atoms, even in rings and spiranes, and (ii) enantiomerism and diastereomerism of allenes including *cis/trans*-isomerism.

Art Unit: 2128

Official notice is taken that a skilled artisan would understand that there are a limited group of possible symmetries and would employ them as appropriate. Also, see (Helson) chapter 4 (examples of symmetry).

Response to Arguments

14. Applicants have made no arguments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hugh Jones whose telephone number is (571) 272-3781. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on (571) 272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hugh Jones/
Primary Examiner, Art Unit 2128